

AUG. 9. 2004 12:57PM

RMS Patent Department

OFFICIAL

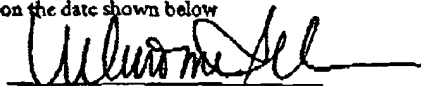
RECEIVED
NATIONAL FAX CENTER

AUG 09 2004

CERTIFICATE OF MAILING (37 C.F.R. 1.8(a))

I hereby certify that this Response (along with any paper referred to as being attached) is being transmitted via facsimile 703-872-9306 to Mail Stop Non Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below

Date: 8-9-04


Winsome St. Rose

DOCKET NO. 18242-US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:

Jorg Kleiber, et al.
SERIAL NO.: 09/756,743
FILED: January 10, 2001
FOR: MAGNETIC PIGMENT

EXAMINER: David M. Naff
ART UNIT: 1651
Confirmation No. 1340

RESPONSE UNDER 37 C.F.R. 1.111

Mail Stop Non Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action mailed February 11, 2004 in connection with the above-identified application, Applicants respectfully request consideration of the following amendments and remarks:

Amendments to the Specification, beginning on Page 2;

Amendments to the Claims, beginning on Page 3; and

Remarks, beginning on Page 4.

In addition, filed herewith are two (2) Terminal Disclaimers under 37 C.F.R. 1.321(c).

AUG. 9. 2004 12:58PM

RMS Patent Department

NO. 340 P. 5

Atty Docket: 18242-US1
Serial No. 09/736,743
Filed January 10, 2001
Page 5 of 5

patent that issues from the present application over the terms of US Patents 6,562,568 and 6,255,477. Accordingly, Applicants request withdrawal of the rejections for obviousness-type double patenting.

VI. CONCLUSION

For the above reasons, Applicants submit that all of the pending and presently considered claims are in condition for allowance. Thus, Applicants respectfully request issuance of a Notice of Allowance. Should the Examiner believe that a telephone conference would expedite consideration of this application, he is invited to contact the undersigned at the number listed below.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 50-0812. Please address all correspondence regarding this matter to Customer No. 22829.

Respectfully submitted,

Date: 8/4/04

Charles M. Doyle

Charles M. Doyle, Ph.D.
Reg. No. 39,175

Roche Molecular Systems, Inc.
1145 Atlantic Avenue
Alameda, CA 94501
Tele: (510) 814-2800
Fax: (510) 814-2973

AUG. 9. 2004 12:58PM

RMS Patent Department

NO. 340 P. 6

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Jorg Kleiber

Confirmation No.: 1340

Application No.: 09/756,743

Group Art Unit: 1651

Filed: January 10, 2001

Examiner: Naff, David M.

For: MAGNETIC PIGMENT

Atty. Dkt. No.: 1803-337

TERMINAL DISCLAIMER

Commissioner for Patents
P.O. Box 1430
Alexandria, VA 22313-1430

Sir:

Your Petitioner, Charles M. Doyle, represents that he is an attorney of record in the above identified application by operation of appointment as an associate attorney of record under 37 CFR 1.34(b). An Associate Power of Attorney is filed herewith.

The above identified application is a continuation of Application No. 08/952,969, filed March 11, 1998, now issued as U.S. Patent No. 6,255,477, which is a 371 of PCT/EP96/02459, filed June 6, 1996.

Petitioner hereby disclaims the terminal part of any patent granted on the above identified application which would extend beyond the expiration date of U.S. Patent No. 6,562,568 which issued on May 13, 2003 and hereby agrees that any patent so granted on the above identified application shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to U.S. Patent No. 6,562,568.

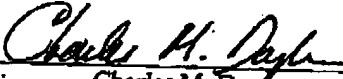
Petitioner further agrees that this agreement is to run with any patent granted on the above identified application and is to be binding upon the grantee, its successors, and assigns.

Petitioner does not disclaim any terminal part of any patent granted on the above-identified application prior to the expiration date of the full statutory term of U.S. Patent No. 6,562,568 in the event that said patent later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. 1.321(a), has all claims canceled by a reexamination certificate, or is otherwise terminated prior to the expiration of its full statutory term, except for the separation of legal title stated above.

Petitioner hereby confirms that he has reviewed the assignment and, to the best of his knowledge and belief, title is in the assignee seeking to take action in this matter and that he is empowered to act on behalf of Roche Diagnostics GmbH.

Petitioner hereby declares that all statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Signed this 9th day of August, 2004.


Name: Charles M. Doyle
Registration Number: 39,175